



## SUPPLEMENTAL APPEAL BRIEF TRANSMITTAL LETTER

October 18, 2004

MAIL STOP APPEAL BRIEF - PATENTS  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450

Re: Appellants: Carns et al.  
Assignee: ZiLOG, Inc.  
Title: "Process to Improve High Performance Capacitor  
Properties in Integrated MOS Technologies"  
Serial No.: 09/351,544 Filed: July 12, 1999  
Examiner: Paul E. Brock II Art Unit: 2815  
Atty. Docket No.: ZIL-204

Dear Sir:

Transmitted herewith are the following documents:

- (1) Request for Reinstatement of Appeal and Supplemental Appeal Brief (30 pages);
- (2) Request for Oral Hearing (1 page);
- (3) Return Postcard; and
- (4) This transmittal sheet (in triplicate).

- ☒ No additional Fee is required.  
☐ The fee has been calculated as shown below:

CLAIMS AS AMENDED						
	REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT	RATE	ADDITIONAL FEE
TOTAL CLAIMS	27*	minus	61	0	\$18	\$0.00
INDEP. CLAIMS	3	minus	12	0	\$88	\$0.00
Total Additional Claim Fee						\$0.00
Fee for Appeal Brief [§1.17(c)] of \$330**						\$0.00
Fee for Request for Oral Hearing [§1.17(d)] of \$290**						\$0.00
Fee for Extension of Time ( __ month)						\$0.00
* includes 6 withdrawn claims						\$0.00
** previously paid						\$0.00
TOTAL						\$0.00

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By Darien K. Wallace 10/18/04  
Darien K. Wallace

Date of Deposit: October 18, 2004

Respectfully submitted,

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellants: Carns et al.

Assignee: ZiLOG, Inc.

Title: "Process to Improve High Performance Capacitor Properties in Integrated MOS Technologies"

Appl. No.: 09/351,544

Filing Date: July 12, 1999

Examiner: Paul E. Brock II

TC/Art Unit: 2815

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Mail Stop Appeal Brief - Patents  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR REINSTATEMENT OF APPEAL  
AND  
SUPPLEMENTAL APPEAL BRIEF**

Dear Sir:

Appellants hereby request, pursuant to 37 CFR § 1.193(b)(2)(ii), reinstatement of the appeal first noticed on April 20, 2004. This Request For Reinstatement is accompanied by this Supplemental Appeal Brief, filed in triplicate, pursuant to MPEP § 1208.02. This Request For Reinstatement is also accompanied by a separate, renewed, written request for an oral hearing.

**I. REAL PARTY IN INTEREST**

The real party in interest is the assignee, ZiLOG, Inc., as named in the caption above.

**II. RELATED APPEALS AND INTERFERENCES**

Based on information and belief, there are no appeals or interferences that could directly affect or be directly affected by or have a bearing on the decision

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by the Board of Patent Appeals and Interferences (the "Board") in the pending appeal.

### III. STATUS OF CLAIMS

The application at issue, filed on July 12, 1999, included 30 claims. In various amendments, claims 31-114 were added, and claims 1-2, 12-35, 40-71 and 75-101 were cancelled. In a final office action dated January 20, 2004, the Examiner withdrew claims 109-114 due to the claims being drawn to a constructively elected invention. Appellants reserved the right to pursue claims 109-114 at a later time.

The office action dated January 20, 2004, was responsive to an amendment dated November 3, 2003 (referred to in the office action as a communication filed on "06 November 2003"). The office action dated January 20, 2004, finally rejected claims 3-11, 36-39, 72-74, 102-108. Appellants responded with a response dated March 16, 2004, in which no claims were added, amended or cancelled. An advisory action dated March 31, 2004, stated that claims 3-11, 39, 72-74, 102-108 were rejected, and claims 109-114 were withdrawn. The advisory action dated March 31, 2004, did not mention claims 36 and 37. Appellants filed a first appeal brief on June 21, 2004, which was accompanied by an amendment in which Appellants cancelled claims 107-108. Thus, claims 3-11, 36-39, 72-74 and 102-106 were the subject of the first appeal.

The Examiner did not submit an answer to the first appeal brief dated June 21, 2004, but rather reopened prosecution and entered an Office Action dated August 12, 2004 (the "Office Action"). The Office Action is not responsive to the arguments of Appellants in the first appeal brief. The Office Action states that it is responsive to the amendment dated November 3, 2003 (referred to in the Office Action as a communication filed on "06 November 2003"). In the Office Action, claims 3-11, 36-39, 72-74, 102-108 stand finally rejected. Considering that Appellants cancelled claims 107-108 in the amendment that

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accompanied Appellants' first appeal brief dated June 21, 2004, claims 3-11, 36-39, 72-74, 102-106 are the subject of this Appeal.

#### IV. STATUS OF AMENDMENTS

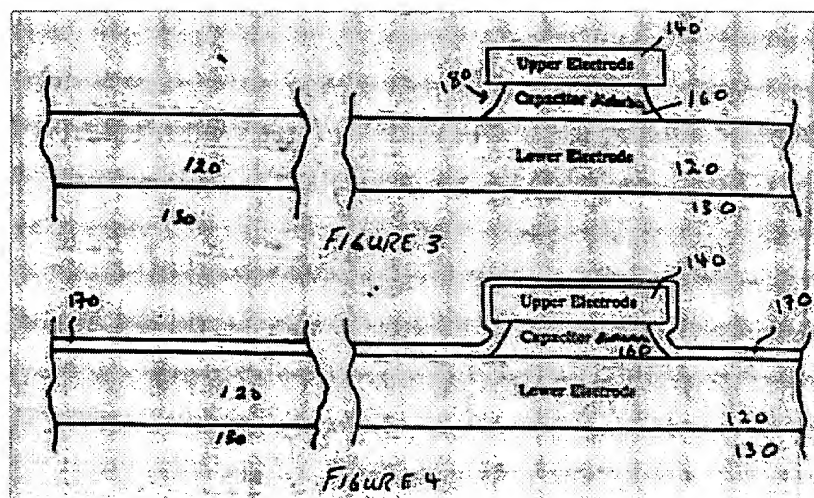
Of the claims 3-11, 36-39, 72-74, 102-106 that are the subject of this Appeal, Appellants added claims 102-106 in the amendment dated November 3, 2003. In the amendment dated November 3, 2003, no other changes were made to the claims that are the subject of this Appeal, and no amendments were made to the drawings or to the specification.

No amendments were made in the response dated March 16, 2004 that was filed subsequent to the final office action dated January 20, 2004. In the amendment that accompanied Appellants' first appeal brief dated June 21, 2004, claims 107-108 were cancelled, but no other changes were made. Therefore, the statement at paragraph 12 of the Office Action, "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action" is inaccurate. No amendment accompanies this Supplemental Appeal Brief. The listing of claims in the Appendix (section XI below) is identical to the listing of claims submitted with Appellants' first appeal brief dated June 21, 2004.

The Examiner did not submit an answer to the first appeal brief, but rather reopened prosecution and entered the Office Action, which cited multiple prior art references for the first time. The new ground of rejection in the Office Action was made final, even though it was neither (A) necessitated by an amendment by Appellants (as no such amendment was made), nor (B) based on information presented in an information disclosure statement. See MPEP § 1208.02 Reopening of Prosecution After Appeal.

## V. SUMMARY OF INVENTION<sup>1</sup>

A capacitor is formed in an integrated circuit by forming a lower electrode layer (120) on a semiconductor body (130), as shown in figures 3 and 4 of the above-captioned patent application. (See figures 3 and 4 below.) A dielectric layer (160) is formed over a portion of the lower electrode layer (120), and an upper electrode layer is formed over a portion of the dielectric layer (160). A portion of the upper electrode layer is removed to expose a portion of the dielectric layer, thereby forming an upper electrode (140) of a capacitor with a lateral boundary such that a portion of the dielectric layer is disposed in an inter-electrode region (180). The inter-electrode region (180) is within the lateral boundary of the upper electrode (140) and between the lower electrode layer (120) and the upper electrode (140).



A portion of the exposed portion of the dielectric layer is subsequently removed to expose a portion of the lower electrode layer, whereby a portion of the dielectric layer is removed from the inter-electrode region (180). Appellants' patent application states, "An unwanted consequence of step 10 is that, as discussed in the background section, some of the wanted dielectric is also

<sup>1</sup> The following summary pursuant to 37 CFR §1.192(a)(5) is a concise explanation of the claims and is to be read in light of the disclosure. This

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removed. This is the undercutting indicated in Figure 3 at 180" (Application specification, page 10, lines 28-30). A conformal insulating layer (170), as shown in figure 4 of Appellants' application, is subsequently formed over a portion of the exposed portion of the lower electrode layer (120) proximate to the portion of the dielectric layer that is disposed within the inter-electrode region (180), thereby forming a portion of the conformal insulating layer (170) within the inter-electrode region. Then an anti-reflective layer (ARL) is formed over a portion of the conformal insulating layer (170) for use in a photolithographic process.

## VI. ISSUES

The issues on appeal are:

- 1) Whether the Examiner can force Appellants to label figures 2 and 3 as "Prior Art" when, in fact, figures 2 and 3 do not depict the prior art.
- 2) Whether claims 3, 8-11, 36, 39, 74 and 102-105 are unpatentable under 35 U.S.C. § 103 over Takahashi (USP 5,683,931) in view of Watanabe (USP 6,225,658), Pfiester (USP 4,966,864) and Bencher et al. ("Dielectric Antireflective coatings for DUV Lithography", Solid State Technology, March 1997, p. 109).
- 3) Whether claims 4-7, 37-38 and 106 are unpatentable under 35 U.S.C. §103 over Takahashi, Watanabe, Pfiester and Bencher, in further view of Wang et al. (USP 5,545,585).
- 4) Whether claims 72-73 are unpatentable under 35 U.S.C. §103 over Takahashi, Watanabe, Pfiester and Bencher, in further view of Jain et al. (USP 5,741,626).

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summary does not limit the claims. (See MPEP §1206)

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## VII. GROUPING OF CLAIMS

Although claims 3-11, 36-39, 72-74 and 102-106 stand together, they do not fall together. Claims 3, 36 and 103 are independent claims of differing scope, each including subject matter distinct from one another. Each of claims 3, 36 and 103, however, recites a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. Thus, each of the claims 3-11, 36-39, 72-74 and 102-106 contains the limitation of a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. Claim 102 contains the additional limitation of using isotropic wet etching.

Claims 4-11, 74 and 102 depend from claim 3 and include limitations in addition to those of claim 3. Claims 37-39 depend from claim 36 and include limitations in addition to those of claim 36. Claim 73 depends from claim 72 and includes a limitation in addition to those of claim 72. Claims 104-106 depend from claim 103 and include limitations in addition to those of claim 103.

## VIII. ARGUMENT

### A. Figures 2 and 3 do not depict prior art (Issue No. 1)

Issue No. 2 of Appellants' first appeal brief dated June 21, 2004, concerned "[w]hether the Examiner can force Appellants to label figures 2 and 3 as "Prior Art" and whether the Examiner has incorrectly characterized as "Applicant's admitted prior art (AAPA)" the Appellants' recognition that the undercutting is the source of a problem." The office action dated January 20, 2004, contained rejections under 35 U.S.C. § 103 based on various references plus the AAPA. In the Office Action, however, the Examiner has now substituted two new references in place of the AAPA referred to in the office action dated January 20, 2004.

Although all references to the AAPA have been removed from the Office Action, the first six paragraphs of the Office Action remain identical to the first six

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paragraphs of the office action dated January 20, 2004. The objection in paragraph six still requires Appellants to label figures 2 and 3 as "Prior Art." The Examiner repeats that "Figures 2 and 3 should be designated by a legend such as –Prior Art— . . . A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application" (Office Action, page 3, lines 6-8).

The objection to figures 2 and 3 now has no supporting argument and constitutes an artifact of an abandoned position. The argument Appellants presented in the first appeal brief dated June 21, 2004, as to why figures 2 and 3 do not depict prior art remains valid. The teachings in Appellants' application specification of (a) the existence of undercutting in an inter-electrode region, and (b) a problem associated with undercutting when the structure is covered by an anti-reflective layer (ARL) do not appear in a section of Appellants' specification entitled "PRIOR ART." Instead, the section is called "Background of the Invention." Appellants' patent application states, "Figure 2 shows an embodiment of the present invention at the state where the upper electrode has been defined. Figure 3 shows the same embodiment after the excess capacitor dielectric has been removed" (Application specification, page 7, lines 26-29). Appellants' patent application also states, "An unwanted consequence of step 10 is that ... some of the wanted dielectric is also removed. This is the undercutting indicated in Figure 3 at 180" (Application specification, page 10, lines 28-30). Appellants state for the record that the problem they have identified is not prior art. Figures 2 and 3 were not designated by a legend such as "Prior Art" because they do not depict prior art but rather the source of a problem identified by Appellants and solved by the Appellants' inventions.

B. Claims 3, 8-11, 36, 39, 72-74 and 102-105 (Issue No. 2)

In the previous office action dated January 20, 2004, the Examiner rejected claims 3, 8-11, 36, 39, 72-74, 102-105 and 107-108 under 35 U.S.C. §103 for being rendered obvious over a three-way combination of Takahashi



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(USP 5,683,931), the AAPA, and Bencher et al. ("Dielectric Antireflective coatings for DUV Lithography", Solid State Technology, March 1997, p. 109). Claims 107-108 are not the subject of this Appeal because they were cancelled in the amendment that accompanied Appellants' first appeal brief dated June 21, 2004. In the current Office Action, the Examiner substitutes Watanabe (USP 6,225,658) and Pfister (USP 4,966,864) for the AAPA. The Examiner now rejects claims 3, 8-11, 36, 39, 72-74, 102-105 and 107-108 under 35 U.S.C. §103 for being rendered obvious over a four-way combination of Takahashi, Watanabe, Pfister and Bencher.

The Examiner rejects each of independent claims 3, 36 and 103 with substantially the same argument.

i. Independent claim 3.

Independent claim 3 has seven elements (a) through (g): "(a) forming a lower electrode layer on a semiconductor body; (b) forming a dielectric layer over a portion of said lower electrode layer; (c) forming an upper electrode layer over a portion of said dielectric layer; (d) removing a portion of said upper electrode layer to expose a portion of said dielectric layer, thereby forming an upper electrode with a lateral boundary, wherein a portion of said dielectric layer is disposed in an inter-electrode region, said inter-electrode region disposed within said lateral boundary of said upper electrode and between said lower electrode layer and said upper electrode; (e) subsequently removing a portion of said exposed portion of said dielectric layer to expose a portion of said lower electrode layer, wherein a portion of said dielectric layer is removed from said inter-electrode region; (f) subsequently forming a conformal insulating layer over a portion of said exposed portion of said lower electrode layer proximate to said portion of said dielectric layer disposed in said inter-electrode region, whereby a portion of conformal insulating layer is formed in said inter-electrode region; and (g) forming an anti-reflective layer (ARL) for use in a photolithographic process over a portion of said conformal insulating layer."

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The Examiner states, with regard to claim 3, that Takahashi discloses elements (a), (b), (c) and (d). The Examiner admits that Takahashi does not disclose element (e):

"Takahashi discloses in figure 2c subsequently removing a portion of the exposed portion of the dielectric layer to expose a portion of the lower electrode layer. Takahashi is silent to a method of etching this process step and wherein a portion of the dielectric layer is removed from the inter-electrode region." (Office Action, p. 4, lines 9 – 13)

The Examiner introduces Watanabe with regard to claim 3, but admits that Watanabe also does not disclose element (e):

"Watanabe teaches in figures 2c and 2d, and column 5, lines 54-62, specifically line 60, a method of etching a capacitor dielectric layer (10) using wet etching. It would have been obvious to one of ordinary skill in the art at the time of the present invention to use the wet etching of Watanabe in the method of Takahashi in order to use an etching process that is well understood in the art. It is not clear that Takahashi and Watanabe teach wherein a portion of the dielectric layer is removed from an inter-electrode region." (Office Action, p. 4, lines 13 – 18)

Still with regard to claim 3, the Examiner introduces Pfister. But the Examiner does not state that Pfister discloses element (e). Instead, the Examiner asserts that it would have been obvious to combine Pfister with Watanabe and Takahashi to arrive at element (e):

"Pfister teaches in figure 2 and column 3, lines 12-15 wherein an undercutting occurs during wet etching. It would have been obvious to

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one of ordinary skill in the art at the time of the invention that a portion of the dielectric layer is removed from an inter-electrode region while using the wet etch of Watanabe in the method of Takahashi because undercutting is a property of wet etch as taught by Pfister in figure 2 and column 3, lines 12-15. It would have been obvious to one of ordinary skill in the art to use the etching step resulting in removing a portion of the dielectric layer in an inter-electrode region of Watanabe and Pfister in the method of Takahashi in order to perform the etching step suggested, but not defined, in column 2, lines 20-23, of Takahashi using a process well known as suggested by the cited sections of Watanabe and Pfister." (Office Action, p. 4, line 21 – p. 5, line 5)

Still with regard to claim 3, the Examiner asserts that it would have been obvious to combine Pfister with Watanabe and Takahashi to arrive at element (f):

"Takahashi discloses in figure 2d subsequently forming a conformal insulating layer (307) over a portion of the exposed portion of the lower electrode layer proximate to the portion of the dielectric layer disposed in the inter-electrode region. It would have been further obvious in the method of Takahashi, Watanabe, and Pfister whereby a portion of the conformal insulating layer is formed in the inter-electrode region. Takahashi discloses in figure 2e etching the bottom electrode layer using a photolithographic mask (309) subsequent to forming the conformal insulating layer." (Office Action, p. 5, lines 5 – 11)

The Examiner then admits that the hypothetical Takahashi/Watanabe/Pfister combination fails to include an anti-reflective layer of element (g). The Examiner therefore cites another reference, Bencher, and states:

"Takahashi, Watanabe, and Pfiester are silent to teaching forming an anti-reflective layer (ARL) over at least a portion of the conformal insulating layer. Bencher teaches in the last paragraph before the Dielectric ARC Design section forming an anti-reflective layer (ARL) for use in a photolithographic process over at least a portion of a resultant structure. It would have been obvious to one of ordinary skill in the art at the time of the present invention to use the antireflective layer of Bencher subsequent to forming the conformal insulating layer and before forming the photolithographic mask in the method of Takahashi and the AAPA in order to improve the photolithographic mask in the method of Takahashi, Watanabe, and Pfiester in order to improve the photolithographic process by reducing net linewidth variations as is well known in the art." (Action, p. 5, lines 11 – 20)

ii. Independent claim 36.

Independent claim 36 has six elements: "(a) forming a conductive layer on a semiconductor body; (b) forming a capacitor structure, comprising: a top electrode over a portion of said conductive layer, wherein said top electrode has a lateral boundary; and a dielectric layer between said top electrode and said conductive layer; (c) forming a conformal insulating layer over said capacitor structure and a portion of said conductive layer proximate to said capacitor structure, wherein a portion of said conformal insulating layer is formed in an inter-electrode region within said lateral boundary of said top electrode and between said top electrode and said conductive layer; (d) forming an anti-reflective layer (ARL) for use in a photolithographic process over a portion of said conformal layer; (e) forming a patterned mask over said anti-reflective layer (ARL); and (f) etching said conductive layer using said patterned mask."

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With regard to claim 36, the Examiner asserts that it would have been obvious to combine Pfiester with Watanabe and Takahashi to arrive at element (c):

"Pfiester teaches in figure 2 and column 3, lines 12-15 wherein an undercutting occurs during wet etching. It would have been obvious to one of ordinary skill in the art at the time of the invention that a portion of the dielectric layer is removed from an inter-electrode region within the lateral boundary of the top electrode and between the top electrode and the conductive layer while using the wet etch of Watanabe in the method of Takahashi because undercutting is a property of wet etch as taught by Pfiester in figure 2 and column 3, lines 12-15. It would have been obvious to one of ordinary skill in the art to use the etching step resulting in removing a portion of the dielectric layer in an inter-electrode region within the lateral boundary of the top electrode and between the top electrode and the conductive layer of Watanabe and Pfiester in the method of Takahashi in order to perform the etching step suggested, but not defined, in column 2, lines 20-23, of Takahashi using a process well known as suggested by the cited sections of Watanabe and Pfiester." (Office Action, p. 6, line 21 – p. 7, line 10)

iii. Independent claim 103.

Independent claim 103 has seven elements: "(a) forming a lower electrode layer upon an underlying layer of a semiconductor device; (b) forming a capacitor dielectric layer; (c) forming an upper electrode layer, wherein said capacitor dielectric layer is disposed in an inter-electrode region between said lower electrode layer and said upper electrode layer; (d) removing a portion of said upper electrode layer such that an upper electrode is formed having an edge; (e) removing a portion of said dielectric layer such that an exposed portion of said

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lower electrode layer is formed and such that an undercutting is formed in said inter-electrode region underneath said edge of said upper electrode, wherein said dielectric layer is absent from said undercutting; (f) providing a conformal insulating layer over said upper electrode and over said exposed portion of said lower electrode layer such that said undercutting is filled in by said conformal insulating layer; and (g) providing a anti-reflective layer over said conformal insulating layer.”

With regard to claim 103, the Examiner asserts that it would have been obvious to combine Pfiester with Watanabe and Takahashi to arrive at element (f):

“Pfiester teaches in figure 2 and column 3, lines 12-15 wherein an undercutting occurs during wet etching. It would have been obvious to one of ordinary skill in the art at the time of the invention that a portion of the dielectric layer is removed and an undercutting is formed underneath said edge of said upper electrode, wherein said dielectric layer is absent from said undercutting from an inter-electrode region while using the wet etch of Watanabe in the method of Takahashi because undercutting is a property of wet etch as taught by Pfiester in figure 2 and column 3, lines 12-15. It would have been obvious to one of ordinary skill in the art to use the etching step resulting in removing a portion of the dielectric layer an undercutting is formed in said inter-electrode region underneath said edge of said upper electrode, wherein said dielectric layer is absent from said undercutting of Watanabe and Pfiester in the method of Takahashi in order to perform the etching step suggested, but not defined, in column 2, lines 20-23, of Takahashi using a process well known as suggested by the cited sections of Watanabe and Pfiester.” (Office Action, p. 9, lines 8 – 20)

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Appellants' Response

The Examiner rejects claims 3, 8-11, 36, 39, 74 and 102-105 under 35 U.S.C. §103 as being obvious over a four-way combination of Takahashi, Watanabe, Pfister and Bencher. Claims 3, 36 and 103 are independent claims, and the remaining claims depend from those claims. The Examiner's rejection should be withdrawn because at least one element of each of independent claims 3, 36 and 103 is not disclosed in any of Takahashi, Watanabe, Pfister or Bencher. Parts of element (f) of claim 3, element (c) of claim 36, and element (f) of claim 103 recite a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting.

Nowhere does any of Takahashi, Watanabe, Pfister or Bencher disclose a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. Moreover, the Examiner has not identified suggestions or motivations in Takahashi, Watanabe, Pfister or Bencher that would motivate one of ordinary skill in the art to combine Takahashi, Watanabe, Pfister and Bencher in a particular way that would result in a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. The Examiner has not identified a motivation to combine Takahashi with Watanabe and then a motivation to combine the combination Takahashi/Watanabe with Pfister, and then a motivation to combine the combination Takahashi/Watanabe/Pfister with Bencher.

i. No *prima facie* case of obviousness.

The Examiner has not established a *prima facie* case of obviousness. The MPEP § 2142 states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when

combined) must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. . . . 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)." MPEP § 2142.

The Examiner does not contend that any of Takahashi, Watanabe, Pfiester or Bencher discloses the limitation of a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. Although Pfiester does disclose an undercutting, the undercutting is not filled with an insulating layer, but rather with a conductive "bridge 26 which electrically couples polycrystalline silicon electrode 16 and substrate 12" (Pfiester, col. 3, lines 24-26). Thus, the inventions of claims 3, 36 and 103 are unobvious over the cited references because the cited references, even when combined, do not teach or suggest the claimed limitation of a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. Thus, the Examiner has not established the third criteria of a *prima facie* case of obviousness.

Although the references do not disclose forming a portion of a conformal insulating layer in an inter-electrode region (the third criteria of a *prima facie* case of obviousness), the Examiner nevertheless argues that it would have been obvious in the method of Takahashi, Watanabe, and Pfiester to form a portion of a conformal insulating layer in an inter-electrode region. The Examiner does not state that the references expressly or impliedly suggest combining themselves in the particular manner and order so as to obtain a conformal insulating layer filled,



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provided or formed in an inter-electrode region or in an undercutting. Indeed, the references do not expressly or impliedly suggest performing various step of Takahashi, then performing a step of Watanabe, then recognizing a condition of Pfiester, then performing another step of Takahashi and then performing a step of Bencher. Nor does the Examiner present a convincing line of reasoning as to why one of ordinary skill in the art would have been led to combine the multiple teachings of the references in the particular manner and order to arrive at the claimed inventions. The Examiner simply repeats "it would have been obvious" and then inserts the various parts of the elements of claim 3, 36 or 103. The Examiner does not present any line of reasoning. Thus, the Examiner has not established the first criteria of a *prima facie* case of obviousness.

ii. No motivation to combine references to obtain the inventions.

Appellants contend that no line of reasoning would lead to a motivation to perform various step of Takahashi and then a step of Watanabe in order to create a condition for a potential problem (the problem being related to a condition of Pfiester but nevertheless unrecognized by Pfiester), then to perform another step of Takahashi in order to prevent the unrecognized problem from occurring when a step of Bencher is performed. This complicated sequence would not have been obvious to one of skill in the art.

In fact, Pfiester teaches away from recognizing the an undercutting condition, when combined with other teachings, could result in a problem. The problem solved by Pfiester is entirely unrelated to undercutting:

"If the opening 22 is etched using a wet etchant or other isotropic etchant, some undercutting of photoresist pattern 20 and electrode 16 will be observed, as illustrated in FIG. 2. If an anisotropic etchant is used, no undercutting will be observed and the resultant opening will be more like that illustrated by the dashed lines 24. The type of etchant used to etch the contact opening, whether wet, dry, isotropic or anisotropic, is not material to the practice of the invention" (Pfiester, col. 3, lines 12 – 21) (emphasis added).

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Although the Examiner does not provide any line of reasoning as to why one of skill in the art would have combined Takahashi, Watanabe, Pfiester and Bencher in a manner and order that might have resulted in a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting, the Examiner does identify one motivation to combine Bencher with a myriad of other references. Randomly combining Bencher with a myriad of references, however, on the chance of happening to combine it with a hypothetical combination of Takahashi/ Watanabe/Pfiester would not have resulted in a reasonable expectation of obtaining a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. Thus, the Examiner has not established the second criteria of a *prima facie* case of obviousness.

The Examiner identifies a motivation "to use the antireflective layer of Bencher subsequent to forming the conformal insulating layer and before forming the photolithographic mask in the method of Takahashi, Watanabe, and Pfiester in order to improve the photolithographic process by reducing net linewidth variations as is well known in the art." (Office Action, p. 5, lines 16 – 20). The motivation identified by the Examiner is not a motivation to combine Bencher specifically with Takahashi, Watanabe, and Pfiester, but rather is only a motivation to combine Bencher with references that seek to solve the problem of excessive variation in net linewidths. That problem is not peculiar to a hypothetical combination of Takahashi, Watanabe, and Pfiester. One of ordinary skill in the art, who was confronted with the problem of reducing net linewidth variations, would not have been motivated to combine Bencher with one particular reference any more than with a myriad of other references. And there would have been no particular motivation to combine Bencher with the hypothetical combination of Takahashi and Watanabe and Pfiester. Moreover, one of ordinary skill in the art, who was confronted with the problem of capacitor leakage, would not have been motivated to combine the hypothetical combination of Takahashi and Watanabe and Pfiester with Bencher because reducing net linewidth variation was not a primary consideration in solving the

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problem of capacitor leakage. Finally, as explained in detail below, one of ordinary skill in the art given the hypothetical combination of Takahashi/Watanabe/Pfiester would not even have been confronted with the problem of capacitor leakage because the capacitor leakage occurs through the anti-reflective layer of Bencher.

Admittedly, the Federal Circuit has held that “[a]s long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor.” In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). See also In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1879, 1901 (Fed. Cir. 1990), cert. denied., 500 U.S. 904 (1991). In this case, however, the Appellants’ inventions include the discovery of the source of a problem, namely that the existence of undercutting increases leakage current in capacitors when they are covered by anti-reflective layers. “[W]here the claimed invention solves a problem, the discovery of the source of the problem and its solution are considered to be part of the ‘invention as a whole’ under 35 U.S.C. 103.” Ex parte Hiyamizu, 10 USPQ2d 1393, 1394-5, (Bd.Pat.App & Interf. Apr 28, 1998), citing In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983) and In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1979) (“[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified.”)

In the present case, it is not pertinent whether the combination of Takahashi, Watanabe, Pfiester and Bencher also has the attribute of solving another problem not confronted by the inventors. There still must be evidence that a “skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998) (emphasis added). One of ordinary skill in the art would not have been motivated to combine Takahashi, Watanabe, Pfiester and Bencher to solve the problem of current leaking through

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an anti-reflective layer from one capacitor plate to another. One of ordinary skill in the art would not have been inclined to use the teaching of Bencher (which discloses an anti-reflective layer) to solve the problem identified by the inventors because the identified problem does not occur unless an anti-reflective layer is used. The Examiner admits that "Takahashi, Watanabe, and Pfiester are silent to teaching forming an anti-reflective layer (ARL) over at least a portion of the conformal insulating layer" (Office Action, p. 5, lines 11 – 13). So the identified problem that results from an antireflective layer would not have presented itself to one of ordinary skill in the art who was in possession of the teachings of Takahashi, Watanabe, and Pfiester.

It is improper for the Examiner to base a *prima facie* case of obviousness on a motivation to combine a last reference (Bencher) with a combination of references (Takahashi/Watanabe/Pfiester) where the motivation to form the combination of references would not have arisen without the last reference. To do so impermissibly defines the problem in terms of its solution. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." Monarch Knitting Mach. Corp. V. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). See also Ecolchem Inc. V. Southern California Edison, 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). The motivation to perform a step of Takahashi (forming a conformal insulating layer after having recognized a condition of Pfiester and after having performed various other step of Takahashi) would not have existed without capacitor leakage caused by a step of Bencher. It is improper for the Examiner to base an obviousness rejection on a motivation to combine a reference that results from a problem other than the problem facing the inventors where the problem facing the inventors would not have existed but for the element or step taught by the reference. Inasmuch as a patentable invention may lie in the discovery of the source of a problem, one of skill in the art and in possession of the teachings of Takahashi, Watanabe, Pfiester and Bencher would never have arrived at the Appellants' inventions because the problem identified by the

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inventors would not have existed given the motivation identified by the Examiner for combining Bencher with a combination of Takahashi/Watanabe/Pfiester.

Claims 8-11, 74 and 102 depend directly or indirectly from claim 3.

Appellants respectfully submit that claims 8-11, 74 and 102 are allowable for at least the same reasons for which claim 3 is allowable. Allowance of claims 8-11, 74 and 102 is requested.

Claim 39 depends from claim 36. Appellants respectfully submit that claim 39 is allowable for at least the same reasons for which claim 39 is allowable. Allowance of claim 39 is requested.

Claims 104-105 depend from claim 103. Appellants respectfully submit that claims 104-105 are allowable for at least the same reasons for which claim 103 is allowable. Allowance of claims 104-105 is requested.

Therefore, the §103 rejection of claims 3, 8-11, 36, 39, 74 and 102-105 as being unpatentable under 35 U.S.C. §103 over Takahashi, Watanabe, Pfiester and Bencher should be withdrawn. Appellants respectfully submit that these claims are allowable.

C. Claims 4-7, 37-38 and 106 (Issue No. 3)

The Examiner rejects claims 4-7, 37-38 and 106 under 35 U.S.C. §103 for being rendered obvious over a five-way combination of Takahashi, Watanabe, Pfiester, Bencher and Wang et al. (USP 5,545,585). Just as the Examiner presents no convincing line of reasoning under Issue No. 2 above as to why one of ordinary skill in the art would have combined the teachings of Takahashi, Watanabe, Pfiester and Bencher, the Examiner also provides no line of reasoning to combine five references in the particular manner and order to arrive at the inventions of claims 4-7, 37-38 and 106.

Moreover, claims 4-7 depend directly or indirectly from claim 3. Thus, dependent claims 4-7 are allowable for at least the same reasons explained above for which claim 3 is allowable. Claims 37-38 depend directly from claim 36. Claims 37-38 are therefore allowable for at least the same reasons

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explained above for which claim 36 is allowable. Claim 106 depends directly on claim 103 and is, therefore, allowable for at least the same reasons explained above for which claim 103 is allowable.

D. Claims 72-73 (Issue No. 4)

The Examiner rejects claims 72-73 under 35 U.S.C. §103 for being rendered obvious over a five-way combination of Takahashi, Watanabe, Pfister, Bencher and Jain et al. (USP 5,741,626). The Examiner provides no line of reasoning as to why one of skill in the art would have combined these five references in the particular manner and order to arrive at the inventions of claims 72-73. Claims 72-73 depend directly or indirectly from claim 3. Thus, dependent claims 72-73 are allowable for at least the same reasons explained above for which claim 3 is allowable.

E. Claim 102

Appellants note that the rejection of claim 102 under 35 U.S.C. §112 that appeared in the office action dated January 20, 2004, does not appear in the Office Action. The Examiner had previously argued that claim 102 fails to meet the written description requirement under 35 U.S.C. §112, first paragraph, because the claim recites "using isotropic wet etching." Issue 4 of the first appeal brief dated June 21, 2004, concerned "[w]hether claim 102 fails to meet the written description requirement under 35 U.S.C. §112, first paragraph, because the claim recites "using isotropic wet etching."

IX. FEES

Prosecution was reopened prior to a decision on the merits by the Board of Patent Appeals and Interferences. Thus, Appellants request that the fees paid by Appellants for the notice of appeal, the appeal brief, and the request for oral hearing be applied to this reinstated Appeal on the same application. See MPEP §1208.02 Reopening of Prosecution After Appeal.

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## X. CONCLUSION

The Examiner has not established a *prima facie* case of obviousness. Each of the claims 3-11, 36-39, 72-74, 102-106 recites a conformal insulating layer filled, provided or formed in an inter-electrode region or in an undercutting. This structural feature is not disclosed in any reference cited by the Examiner. The discovery that undercutting is a source of the problem of current leaking through an anti-reflective layer from one capacitor plate to another is part of Appellants' inventions. The source of the problem identified by Appellants is nowhere recognized in the cited prior art. Moreover, the Examiner has not identified a motivation or suggestion to combine either (i) all of the four references that are the basis for the rejection of claims 3, 8-11, 36, 39, 72-74 and 102-105 or (ii) all of the five references that are the basis for the rejection of claims 4-7, 37-38 and 106. Therefore, Appellants respectfully request that the Board reverse the rejections of pending claims 3-11, 36-39, 72-74 and 102-106 and allow all pending claims.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By

 10/18/04  
Darien K. Wallace

Date of Deposit: October 18, 2004

Respectfully submitted,



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## XI. APPENDIX

Claims 1 – 2 (canceled)

3. (previously presented): A method of forming a capacitor in an integrated circuit comprising:

- (a) forming a lower electrode layer on a semiconductor body;
- (b) forming a dielectric layer over a portion of said lower electrode layer;
- (c) forming an upper electrode layer over a portion of said dielectric layer;
- (d) removing a portion of said upper electrode layer to expose a portion of said dielectric layer, thereby forming an upper electrode with a lateral boundary, wherein a portion of said dielectric layer is disposed in an inter-electrode region, said inter-electrode region disposed within said lateral boundary of said upper electrode and between said lower electrode layer and said upper electrode;
- (e) subsequently removing a portion of said exposed portion of said dielectric layer to expose a portion of said lower electrode layer, wherein a portion of said dielectric layer is removed from said inter-electrode region;
- (f) subsequently forming a conformal insulating layer over a portion of said exposed portion of said lower electrode layer proximate to said portion of said dielectric layer disposed in said inter-electrode region, whereby a portion of conformal insulating layer is formed in said inter-electrode region; and
- (g) forming an anti-reflective layer (ARL) for use in a photolithographic process over a portion of said conformal insulating layer.



4. (previously presented): The method of claim 3, wherein said conformal insulating layer has a thickness ranging from 20 angstroms to 70 angstroms.
5. (previously presented): The method of claim 3, wherein said conformal insulating layer is an oxide layer formed in a thermal process.
6. (previously presented): The method of claim 5, wherein said thermal process is a rapid thermal oxidation (RTO) performed for a length of time ranging from 10 to 60 seconds and at a temperature ranging from 850°C to 1050°C.
7. (previously presented): The method of claim 3, wherein said conformal insulating layer is formed by deposition.
8. (original): The method of claim 3, wherein said ARL is an anti-reflective coating.
9. (original): The method of claim 3, wherein said ARL is titanium nitride.
10. (original): The method of claim 3, wherein said ARL is a plasma enhanced chemical vapor deposition anti-reflective layer (PEARL).
11. (previously presented): The method of claim 10, wherein said plasma enhanced chemical vapor deposition anti-reflective layer (PEARL) has a thickness ranging from 300 angstroms to 400 angstroms.

Claims 12 – 35 (canceled)

36. (previously presented): A method of forming an integrated circuit comprising:

(a) forming a conductive layer on a semiconductor body;

(b) forming a capacitor structure, comprising:

a top electrode over a portion of said conductive layer, wherein said top electrode has a lateral boundary; and

a dielectric layer between said top electrode and said conductive layer;

(c) forming a conformal insulating layer over said capacitor structure and a portion of said conductive layer proximate to said capacitor structure, wherein a portion of said conformal insulating layer is formed in an inter-electrode region within said lateral boundary of said top electrode and between said top electrode and said conductive layer;

(d) forming an anti-reflective layer (ARL) for use in a photolithographic process over a portion of said conformal layer;

(e) forming a patterned mask over said anti-reflective layer (ARL); and

(f) etching said conductive layer using said patterned mask.

37. (previously presented): The method of claim 36, wherein said conformal insulating layer has a thickness ranging from 20 angstroms to 70 angstroms.

38. (previously presented): The method of claim 36, wherein said conformal insulating layer is an oxide layer formed in a thermal process.

39. (previously presented): The method of claim 36, wherein said conductive layer is additionally used to form a gate of one or more transistors formed on said integrated circuit.

Claims 40 – 71 (canceled)

72. (previously presented): The method of claim 3, further comprising:

(h) forming a photoresist mask over a portion of said anti-reflective layer (ARL); and

(i) irradiating said photoresist mask with radiation that penetrates said photoresist mask, wherein said anti-reflective layer reduces a reflection of said radiation by 70% or more.

73. (previously presented): The method of claim 72, wherein the anti-reflective layer reduces said reflection of said radiation by 70% to 85%.

74. (previously presented): The method of claim 3, wherein said anti-reflective layer is a SixONy film.

Claims 75 – 101 (canceled)

102. (previously presented): The method of claim 3, wherein said subsequently removing a portion of said exposed portion of said dielectric layer in step (e) is performed using isotropic wet etching.

103. (previously presented): A method comprising:

- (a) forming a lower electrode layer upon an underlying layer of a semiconductor device;
- (b) forming a capacitor dielectric layer;
- (c) forming an upper electrode layer, wherein said capacitor dielectric layer is disposed in an inter-electrode region between said lower electrode layer and said upper electrode layer;
- (d) removing a portion of said upper electrode layer such that an upper electrode is formed having an edge;
- (e) removing a portion of said dielectric layer such that an exposed portion of said lower electrode layer is formed and such that an undercutting is formed in said inter-electrode region underneath said edge of said upper electrode, wherein said dielectric layer is absent from said undercutting;
- (f) providing a conformal insulating layer over said upper electrode and over said exposed portion of said lower electrode layer such that said undercutting is filled in by said conformal insulating layer; and
- (g) providing a anti-reflective layer over said conformal insulating layer.

104. (previously presented): The method of claim 103, wherein the forming in step (b) is performed by depositing said capacitor dielectric layer to a thickness ranging from 300 angstroms to 800 angstroms.

105. (previously presented): The method of claim 103, wherein said underlying layer electrically isolates said lower electrode layer.

106. (previously presented): The method of claim 103, wherein the providing the conformal insulating layer in step (f) is performed using a rapid thermal oxidation (RTO) process to grow a layer of silicon oxide to a thickness ranging from 20 angstroms to 100 angstroms.

Claims 107 – 108 (canceled)

109. (withdrawn): A device comprising:

- a lower electrode layer disposed on an underlying layer of a semiconductor substrate;

- a capacitor dielectric disposed on said lower electrode layer;
- an upper electrode disposed on said capacitor dielectric, wherein said upper electrode has a lateral boundary, wherein said capacitor dielectric is disposed within an inter-electrode region, said inter-electrode region disposed within said lateral boundary between said lower electrode layer and said upper electrode layer, and wherein an exposed portion of said lower electrode layer lies outside said lateral boundary;

- a conformal layer of an insulating material disposed over said upper electrode and over said exposed portion of said lower electrode layer;

- an undercutting in said inter-electrode region, wherein said capacitor dielectric is absent from said undercutting and said undercutting is filled by said insulating material; and

an anti-reflective layer disposed over said conformal layer of said insulating material.

110. (withdrawn): The device of claim 109, wherein said anti-reflective layer is titanium nitride.

111. (withdrawn): The device of claim 109, wherein said anti-reflective layer is a plasma enhanced anti-reflective layer (PEARL).

112. (withdrawn): The device of claim 109, wherein said lower electrode layer is polysilicon.

113. (withdrawn): A device comprising:

- a lower electrode layer disposed on an underlying layer of a semiconductor substrate;

- a capacitor dielectric disposed on said lower electrode layer;

- an upper electrode disposed on said capacitor dielectric, wherein said upper electrode has a lateral boundary, wherein said capacitor dielectric is disposed in an inter-electrode region, said inter-electrode region disposed within said lateral boundary and between said lower electrode layer and said upper electrode layer, and wherein an exposed portion of said lower electrode layer lies outside said lateral boundary;

- an anti-reflective layer disposed over said upper electrode and over said exposed portion of said lower electrode layer; and

means for preventing an electrical connection through said anti-reflective layer from said upper electrode to said lower electrode layer, wherein said means is at least partially disposed within said inter-electrode region.

114. (withdrawn): The device of claim 113, wherein said anti-reflective layer is a plasma enhanced chemical vapor deposition anti-reflective layer (PEARL).